

Applicant: H. Kinemura
U.S.S.N.: 09/629,339
RESPONSE TO OFFICE ACTION
Page 7 of 14

REMARKS

Applicant appreciates the Examiner's thorough examination of the subject application and requests reconsideration of the subject application based on the foregoing amendments and the following remarks.

Claims 1-8 are pending in the subject application.

Claims 1-8 stand rejected under 35 U.S.C. §103.

Claims 1 and 5 were amended for clarity. Claims 9-13 were added to more distinctly claim aspects/ embodiments of the present invention. The amendments to the claims are supported by the originally filed disclosure.

35 U.S.C. §103 REJECTIONS

Claims 1-8 stand rejected under 35 U.S.C. §103 as being unpatentable over Koperda [USP 5,790,806] in view of Eastmond et al. [USP 5,822,307; "Eastmond"]. Applicant respectfully traverses as discussed below. Because claims 1 and 5 were amended in the instant amendment, the following discussion refers to the language of the amended claims. However, only those amended features specifically relied upon to distinguish the claimed invention from the cited prior art shall be considered as being made to overcome the cited reference.

Applicant claims, claim 1, a cable modem that includes a cable modem proper, an expansion unit and a connecting member. The cable modem proper is configured so as to be connected by way of a coaxial cable to a CATV network and so as to communicate information to/ from the CATV network and the cable modem proper. The expansion unit is configured so as

Applicant: H. Kinemura
U.S.S.N.: 09/629,339
RESPONSE TO OFFICE ACTION
Page 8 of 14

to have a wireless LAN function that permits communication with an information processing terminal on a wireless basis, where the information processing terminal is located remote from the cable modem. The connecting member removably and operably couples the cable modem proper and the expansion unit together by use of a plug and a connector. When the expansion unit is operably coupled to the cable modem proper, information is communicated to/ from the CATV network and the remotely located information processing terminal via the cable modem proper and the expansion unit.

As to Koperda, the Office Action asserts that this reference teaches a cable modem proper that is connected by way of a coaxial cable to a CATV network and this is connected to a LAN interface to user's computer via an Ethernet connection 316 with reference to figure 3 and col. 10, lines 57+. It thus is asserted that the LAN interface reads on the expansion unit except that Koperda does not disclose an expansion unit having a wireless LAN function and being removably coupled to the cable modem.

The Office Action further asserts that Eastmond teaches an expansion unit (Ethernet card 912 and first transceiver 904) having a wireless function and a removable communication device with reference to figure 9 thereof. It thus is concluded in the Office Action that it would have been obvious to one skilled in the art to modify the cable modem in Koperda based on the teachings in Eastmond so as to yield the cable modem as claimed by Applicant. Applicant respectfully disagrees with the characterization of what is allegedly being disclosed and taught in either of these two references as provided below.

As indicated above, it is asserted that the cable modem in Koperda is connected to a LAN interface to a user's computer via an Ethernet connection 316 and that this LAN interface reads on the expansion unit as set forth in claim 1. Applicant respectfully disagrees. The language referred to in column 10 of Koperda indicates, with reference to figure 3, that the user modem is designed to connect to a standard Ethernet 10 Base T interface (a LAN interface) on one side and the cable network on the other side. While this broadly describes the design of the cable modem, the assertion in the Office Action as to what certain features shown in figure 3 are and what they are equivalent to are *not* consistent with the discussion that follows in cols. 11-12 of Koperda. As is indicated in col. 11, the feature identified by reference numeral 316 is not an Ethernet connection but rather is a block diagram representation of the Local Array Network (LAN) itself, more specifically an Ethernet 10 Base T LAN 316 (see col. 11, lines 57-60). As such, this feature in Koperda does *not* relate at all to the cable modem proper or the expansion unit as is set forth in claim 1 of the subject application.

Also, the so-called LAN interface is more specifically identified in Koperda by reference numeral 315, which is more specifically described as being a standard RJ-45 or RJ-11 Ethernet interface chip. It is clear that this cannot be an expansion unit as that term is used in the subject application, but relates if at all to the mechanism being used to operably connect the expansion unit and the cable modem proper to each other.

As such, it is respectfully submitted that Koperda does not disclose, teach nor suggest the expansion unit as set forth in claim 1. It also is respectfully submitted that Koperda also does not teach, suggest or offer any motivation for modifying the cable modem described in Koperda so as

to include both a cable modem proper and an expansion unit that is operably coupled thereto so that is configured so as to have a wireless LAN function.

As to the Eastmond reference, Applicant respectfully submits that when the disclosures of the entire reference are considered, Eastmond does not teach an expansion unit as is set forth in claim 1, nor operably coupling/ connecting an expansion unit as is set forth in claim 1 to a cable modem. It appears that reference is made to the Ethernet card 912 that is being inserted into a laptop computer that would be remotely located from the cable modem. In this regard, the laptop computer most closely relates to the information processing terminal referred to in claim 1, not a cable modem proper or an expansion unit of the present invention.

Moreover, the Office Action appears to ignore other teachings being disclosed and taught in Eastmond, namely the second transceiver 906 that is operably coupled to the 10 Base-T Ethernet network 910. It is clear from the discussion in col. 6, lines 30-64 thereof that information is being communicated to/ from the first transceiver, coupled to the laptop computer, and the 10 Base-T Ethernet network via the second transceiver 906. Thus, what Eastmond discloses and teaches is providing a second transceiver that is positioned in the network so it can transmit wireless signals to remotely located laptops. As is known to those skilled in the art, a cable modem that is interconnected to a CATV network would be operably coupled to a HUB, router or other functionality so that the cable modem could be operably connected to the 10 Base-T Ethernet network, much in the same fashion as illustrated in Fig. 9 of the subject application.

In sum, when all of the teachings of Eastmond are taken into consideration, which is a must in combining references, Eastmond does not teach configuring an expansion unit operably

Applicant: H. Kinemura
U.S.S.N.: 09/629,339
RESPONSE TO OFFICE ACTION
Page 11 of 14

coupled to a cable modem proper so as to in effect make the cable modem have a wireless LAN capability but rather Eastmond teaches coupling the cable modem to a well known 10 Base-T Ethernet network and establishing wireless communication's capabilities by also connecting a transceiver to the same network so that signals can be transmitted wirelessly from the transceiver to a lap top. This clearly is totally different from the cable modem of the present invention as set forth in claim 1.

Applicant respectfully submits that the foregoing comments regarding claim 1 at least apply to distinguish each of claims 2-8 from the cited combination of references.

As provided in MPEP 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F. 2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F. 2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). As provided above, the references cited, alone or in combination, include no such teaching, suggestion or motivation.

Furthermore, and as provided in MPEP 2143.02, a prior art reference can be combined or modified to reject claims as obvious as long as there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Additionally, it also has been held that if the proposed modification or combination would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. Further, and as provided in MPEP-2143, the

teaching or suggestion to make the claimed combination and the reasonable suggestion of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). As can be seen from the forgoing discussion regarding the disclosures of the cited references, there is no reasonable expectation of success provided in the reference(s). Also, it is clear from the foregoing discussion that the modification suggested by the Examiner would change the principle of communication of the device/ circuitry disclosed in Koperda.

The Federal Circuit has indicated in connection with 35 U.S.C. §102 that in deciding the issue of anticipation, the trier of fact must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify *corresponding elements* disclosed in the allegedly anticipating reference (emphasis added, citations in support omitted). *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al.*, 730 F. 2d 1452, 221 USPQ 481,485 (Fed. Cir. 1984). Notwithstanding that the instant rejection is under 35 U.S.C. §103, in the present case the Examiner has not shown that the LAN interface of Koperda corresponds, as that term is used above by the Federal Circuit, in any fashion to the expansion unit in its entire claimed form as set forth in claim 1 of the present invention.

As provided in MPEP-2145 (XD) a prior art reference that "teaches away" from the claimed invention is significant factor to be considered in determining obviousness. It also is provided therein that the *totality* of the prior art must be considered, and proceeding contrary to accepted wisdom in the art is evidence of non-obviousness. *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986) [Italics added for emphasis].

Applicant: H. Kinemura
U.S.S.N.: 09/629,339
RESPONSE TO OFFICE ACTION
Page 13 of 14

As the Federal circuit has stated, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260,1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor. *Para-Ordance Mfg. v. SGS Importers Int'l, Inc.*, 73 F.2d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995).

It is respectfully submitted that for the foregoing reasons, claims 1-8 are patentable over the cited reference(s) and satisfy the requirements of 35 U.S.C. §103. As such, these claims are allowable.

CLAIMS 9-13

As indicated above, claims 9-13 were added to more distinctly claim embodiments/aspects of the present invention. These claims are clearly supported by the originally filed disclosure, including the originally filed claims. It also is respectfully submitted that these added claims are patentable over the cited prior art on which the above-described rejection(s) are based.

OTHER MATTERS

Applicant filed a Supplemental Information Disclosure Statement/ Search Report Information Disclosure Statement dated December 18, 2003 in the USPTO, which IDS post-dates the above-referenced Office Action. Accordingly, Applicant respectfully requests that the Examiner reflect their consideration of this IDS in the next official communication from the

Applicant: H. Kinemura
U.S.S.N.: 09/629,339
RESPONSE TO OFFICE ACTION
Page 14 of 14

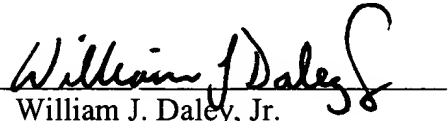
USPTO. Applicant also respectfully requests the Examiner to call the undersigned collect and the below number in the event that this IDS has not been received by the Examiner and thus needs to be again submitted by Applicant for the Examiner's consideration.

It is respectfully submitted that the subject application is in a condition for allowance. Early and favorable action is requested.

Although claims were added to the subject application, Applicant believes that additional fees are not required. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, the Commissioner is hereby authorized and requested to charge Deposit Account No. **04-1105**.

Respectfully submitted,
Edwards & Angell, LLP

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